

## **REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

### **Showing under 37 CFR § 1.116(b)**

At the outset, Applicants wish to address the showing required by 37 CFR § 1.116(b) as to why this amendment is necessary and was not presented earlier. This amendment is responsive to new points made in the final rejection, for example, the refusal to consider the information disclosure statement filed April 27, 2010, the objection to claim 53 and the new scope of conceded enablement, thus, this amendment is necessary. Further, since this is the first substantive response to the final rejection, clearly this amendment could not have been presented earlier. In view of the foregoing, and, also, because this amendment is believed to place this application in condition for immediate allowance, Applicants respectfully request that the Examiner enter and consider this amendment.

### **Substance of Interview**

Applicants wish to thank Examiner Juedes for the courtesy of the interview accorded Applicants' representative earlier today. Prior to the interview, the undersigned provided the

Examiner with a proposed amendment that save for this Substance of the Interview was identical to what is now being submitted.

During the interview, the Examiner indicated that she would consider the Information Disclosure Statement filed April 27, 2010, and charge the deposit account of the undersigned, Deposit Account No. 14-1263, for the fee required by 37 CFR § 1.17(p). The undersigned understood that the Examiner will sign and date the PTO Form 1449 attached hereto, indicating consideration of the references cited in that Information Disclosure Statement.

The Examiner also indicated that she believed that the proposed amendment placed the application in condition for allowance, but she needed final supervisory approval before issuing a Notice of Allowance.

### **Support for Claim Amendments**

The claims have been amended without prejudice to require that “the third or fifth cysteine residue is substituted.” Substitution at the *third* cysteine is supported, for example, by the specification at page 8, paragraph “(3)”; page 9, paragraph “(10)”; page 22, second full paragraph; in conjunction with the location of the cysteines in the CD83 extracellular region as shown for example in Figure 1 and in the sequence listing, *e.g.*, SEQ ID NO:2. Substitution at the *fifth* cysteine is supported by, for example, page 22, third paragraph, Figure 8, showing the sequence, and Example 9, pages 46-47, discussing results obtained with “hCD83ext\_mut

129\_Cys to Ser,” which is a substitution of the fifth cysteine.

Claim 36 has been amended to specify that the third cysteine has been substituted with serine. This amendment is supported by at page 22 of the specification, second full paragraph, which recites, “Particular substitution muteins of the soluble CD83 protein of the inventions are those embodiments of (3) and (10) of the inventions, wherein the soluble CD83 protein is a monomer CD83 protein wherein one or more of the cysteine residues have by same or different small and/or polar amino acid residue(s). Preferably the small and/or polar amino acid residues are selected from serine, alanine, glycine, valine, threonine, etc., *preferably is serine.*” (Emphasis added).

Applicants do not believe that any of the amendments introduce new matter. An early notice to that effect is earnestly solicited.

### **Information Disclosure Statement**

The Examiner refused to consider the information disclosure statement filed April 27, 2010, because it contained no certification as specified in 37 CFR § 1.97(e) or, alternatively, the fee set forth in 37 CFR § 1.17(p). In response, Applicants respectfully point out that page 10 of the amendment filed on the same date contained a general fee authorization authorizing the Office to “charge *any* insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263

(emphasis added).” Such general fee authorizations are expressly allowed according to the rules of practice. See, 37 CFR § 1.25(b). Moreover, MPEP § 509.01(I) expressly provides:

“Many applications contain broad language authorizing any additional fees which might have been due to be charged to a deposit account. The U.S. Patent and Trademark Office *will* interpret such broad authorizations to include authorization to charge to a deposit account fees set forth in 37 CFR 1.16, *and 1.17*.  
[Underlining in original and all other emphasis added.]”

As the Examiner notes, in the absence of the proper certification, the information disclosure statement filed April 27, 2010, required the fee set forth in 37 CFR § 1.17(p) in order to be considered. As the quote above makes perfectly clear, such fee is encompassed by Applicants’ general authorization and, therefore, Applicants’ deposit account should have been charged and the information disclosure statement considered. Indeed, please see the emphasized “will” in the quote above—this language binds an examiner to the indicated procedure, and an examiner is without authority to refuse to consider an information disclosure statement supported by such a general fee authorization provided, of course, the information disclosure statement can, as here, be considered upon the payment of a fee.

In view of the foregoing, Applicants respectfully request that the Examiner now consider the information disclosure statement filed April 27, 2010, and the references cited therein. For the Examiner’s convenience, Applicants supply a new PTO Form 1449, which lists the same references, but, compared to the original, is a bit more detailed to be more meaningful to readers

upon printing of the patent.

### **Oath or Declaration**

The oath or declaration was objected to as containing non-initialed and/or non-dated alterations, and a new oath or declaration was required. In response, Applicants submit a new declaration. The new declaration also contains alterations, but these have been initialed and dated, accordingly, the new declaration should be acceptable.

### **Objection for Informalities**

Claim 53 was objected to as containing the recitation “selected from the group consisting of” when only a single group member was recited. In response, Applicants have adopted the Examiner’s helpful suggestion and deleted the phrase “selected from the group.”

### **Enablement**

Claims 29, 31-33, 35, 36, 46, 49 and 51 were rejected under 35 USC § 112, first paragraph, as being broader than the enabling disclosure. Whereas the previous claims specified

the possibility that "one or more cysteine residues are substituted," the Examiner accepts enablement only for "the third or fifth cysteine residue is substituted." In response, in order to advance the prosecution, Applicants have amended the claims without prejudice to the scope the Examiner indicates is enabled. Applicants expressly reserve the right to prosecute the broader subject matter in a divisional application should this be desired.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
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